

## REMARKS

Claims 19 and 20 stand rejected under 35 USC §112, second paragraph as being indefinite for failing to particularly point out and distinctly claim that which Applicant regards as the invention. In particular, the Examiner has refused to give patentable weight to the recitation within claim 19 of “said foot board assembly being adapted to articulate relative to said first section, from a resting position, when a force is applied thereto, but to increasingly resist said force with increasing degree of articulation.” Office Action, ¶2 (July 2, 1999). In support of her position, the Examiner has cited *In re Fuller*, 17 C.C.P.A. 571, 35 F.2d 62 (1929), for the proposition that “[i]n order to be given patentable weight, a functional recitation must be expressed as a ‘means’ for performing the specified function, as set forth in 35 USC §112, sixth paragraph, and must be supported by recitation in the claim of sufficient structure to warrant the presence of the functional language.” Office Action, ¶2 (citing *Fuller*). A number of issues are immediately raised by the Examiner’s action.

First, it is clear from the improper reliance on *Fuller* that the Examiner has either entirely misapprehended the holding of *Fuller* or, worse, is now engaging in irresponsibly inaccurate resort to decisional law in an unwarranted attempt to prevent patenting of the present invention. In evidence of this admittedly strong accusation, Applicant notes the following: (1) *Fuller* was decided in 1929 – some 23 years prior to the enactment of 35 USC §112, sixth paragraph, *see* Patent Act of July 19, 1952, ch. 950, 66 Stat. 798 (codified as amended at 35 USC §112), – and could not have mandated resort to the as of then not yet enacted referenced statute; (2) *Fuller* requires only that claim recitations be sufficiently clear and precise as to prevent broader meaning than is supported by the specification, *see Fuller*, 17 C.C.P.A. at 572, 35 F.2d at 62; and (3) although not entirely inconsistent with the modern view, *Fuller* reflects an antedated interpretation of the patent laws, *see generally* DONALD S. CHISUM, CHISUM ON PATENTS §8.04 (1998) (distinguishing modern view toward functional language from older cases condemning functional recitations), and, as such, must not be cited for propositions of law that under the present state of the law are clearly incorrect.

Additionally, and necessitating the strong objection now set forth, Applicant notes that the Examiner's present misstatement of law is not the first in the prosecution of this application. *See* Preliminary Amendment dated April 30, 1999, pages 7-9 (conclusively rebutting Examiner's improper reliance upon *Application of Hutchison*, 33 C.C.P.A. 879, 154 F.2d 135 (1946); *Ex parte Masham*, 2 U.S.P.Q.2d (BNA) 1647 (B.P.A.I. 1987); and *Kalman v. Kimberly-Clark Corp.*, 713 F.2d 760 (Fed. Cir. 1983), *cert. denied* 465 U.S. 1026 (1984), *overruled on other grounds by SRI Intern. v. Matsushita Elec. Corp. of America*, 775 F.2d 1107 (Fed Cir. 1985) (in banc)). The patent laws are authorized for the promotion of the useful arts through the reward of innovation. U.S. Const. art. I, §8, cl. 8. By Congressional mandate in exercise of this Constitutional authorization, the U.S. Patent and Trademark Office has a duty, absent contrary provision of law, to grant patent rights to inventors. *See e.g.* 35 USC 102 ("A person *shall be entitled* to a patent *unless*....") (emphasis added) and 35 USC §131 ("if [upon] examination it appears that the applicant is *entitled to a patent under the law*, the Commissioner *shall* issue a patent") (emphasis added). As part of this statutory mandate, the Commissioner of Patents has been charged with the authority, to be exercised consistently with the laws, to determine the patentability of inventions. *See* 35 USC §6(a). It is not, however, within the duties of the Commissioner to prevent the patenting of inventions by unduly burdening applicants with the repeated misinterpretation and/or misapplication of decisional law, which, by any reasonable analysis, can only be said to be a hindrance to the useful arts. *Cf.* U.S. Const. art. I, §8, cl. 8.

In light of the foregoing, Applicant now respectfully demands proper application of the patent laws to the claims of the above-captioned application without further necessity for reply to rejections based upon nonexistent rules. To this end, Applicant respectfully calls the Examiner's attention to *Application of Swinehart*, 58 C.C.P.A. 1027, 439 F.2d 210 (1971), and *Application of Venezia*, 530 F.2d 956 (C.C.P.A. 1976). In *Swinehart*, to which a leading authority on patent law has referred as "probably the most helpful analysis of the problem of 'functionality' in claims language," *see* CHISUM ON PATENTS §8.04[3], the court clearly admonishes that there is nothing intrinsically wrong with the use of functional language in drafting patent claims, the prior cases and statute providing no support for the proposition that

functional language, in and of itself, renders a claim indefinite. *Swinehart*, 58 C.C.P.A. at 1030-31, 439 F.2d at 212-13; *see also In re Schreiber*, 128 F.3d 1473, 1478 (Fed. Cir. 1997) (quoting *Swinehart* favorably). Continuing, the court points out that there are, in reality, only two basic requirements under 35 USC §112 against which functional language in a claim may be tested. *Id.* at 1031-32, 439 F.2d at 213.

The first is that the language used is not precise and definite enough to provide a clear-cut indication of the scope of subject matter embraced by the claim. This ground finds its basis in the second paragraph of section 112.... The second is that the language is so broad that it causes the claim to have a potential scope of protection beyond that which is justified by the specification disclosure. This ground of rejection is now recognized as stemming from the requirements of the first paragraph of [section] 112.

*Id.* (citations omitted). Finally, the court notes that while “[f]unctional’ terminology may render a claim quite broad,” it will often be the case that only a very limited group of objects will fall within the recited category. *Id.* at 1032, 439 F.2d at 213. Having conclusively shown that the Examiner’s resort to 35 USC §112, sixth paragraph is completely misplaced in a rejection under 35 USC §112, second paragraph, Applicant turns at last to the claims of the present invention, the examination of which is enlightened by reference to *Application of Venezia*.

In claim 19, Applicant recites, *inter alia*, “said foot board assembly being adapted to articulate relative to said first section, from a resting position, when a force is applied thereto, but to increasingly resist said force with increasing degree of articulation.” Claim 19. As a result, claim 19 is precisely limited to reading upon structures having a particular first element particularly adapted to articulate in a particular manner with respect to a particular second element such that a particular result may be achieved. *See Venezia*, 530 F.2d at 959 (finding “nothing wrong in defining the structures’ of the components of [an] assembly in terms of the interrelationship of the components, or the attributes they must possess, in the completed assembly”). The metes and bounds of the present invention being defined, through the functional language of claim 19, with a reasonable degree of precision and particularity, claim 19 is fully compliant with the statutory requirement for definiteness. *See id.* at 958. Applicant therefore respectfully requests reconsideration and withdrawal of the rejection of claims 19 and 20.

Claim 1 stands rejected under 35 USC §103(a) as being unpatentable over U.S. patent No. 4,409,695 issued October 18, 1983 to Johnston *et al.* ("Johnston") in view of U.S. patent No. 4,858,260 issued August 22, 1989 to Failor *et al.* ("Failor"). Additionally, claims 2 through 13, 15 through 19, 21 and 22 stand rejected under 35 USC §103(a) as being unpatentable over Johnston in view of Failor and U.S. patent No. 5,205,004 issued April 27, 1993 to Hayes *et al.* ("Hayes"). Finally, Claim 14 stands rejected under 35 USC §103(a) as being unpatentable over Johnston in view of Failor, Hayes and U.S. patent No. 5,393,938 issued February 28, 1995 to Bumbalough ("Bumbalough"). Although Applicant will traverse each rejection on the merits of the rejection of claim 1, Applicant now states that it does not in any manner admit that Bumbalough is prior art to the invention of the present application and does not waive any right to later present evidence establishing the same. In any case, for the following reasons, Applicant respectfully traverses each said rejection.

The test of obviousness *vel non* is statutory. *In re Ochiai*, 71 F.3d 1565, 1569 (Fed. Cir. 1995). In order to establish obviousness, it must be shown that the claimed subject matter, taken "as a whole," would have been "obvious at the time the invention was made to a person having ordinary skill in the art to which [the] subject matter pertains." 35 USC §103(a). A proper showing, however, must rest upon several factual inquiries: (1) the scope and content of the prior art; (2) the differences between the prior art and the invention as claimed; (3) the level of ordinary skill in the art; and (4) the objective evidence of non-obviousness. *See Graham v. John Deere Co.*, 383 U.S. 1 (1966).

Looking first to the cited references as exemplary of the prior art, it is first noted that Johnston is directed toward an adjustable bed specifically adapted for the care of morbidly obese patients, i.e. patients weighing between 300 and 700 pounds. The bed of Johnston is provided with an adjustable mattress support, including a leg section, a seat section and a head section and a mechanism for articulation of the head and leg sections with respect to the seat section. Importantly, Johnston also discloses that the bed must comprise "great structural rigidity and strength to accommodate patients weighing between 300 and 700 pounds." To this end, Johnston teaches that the mattress support should be positioned above the frame of the bed by spaced pedestals reinforced with a number of gussets. As such, Johnston appears to

fully appreciate the state of the art for handling of bariatric patients as existed prior to Applicant's invention, i.e. that bariatric patients are very difficult to handle and, at that time, could not be freely maneuvered due to the structural requirements necessitated by patient safety concerns.

Failor, on the other hand, appears to appreciate many aspects of the state of the art for handling of normal weight patients as existed at about the time of Applicant's invention, to wit Failor discloses a patient transport apparatus including an articulating support atop a frame with a raise-and-lower mechanism interposed therebetween. Although Applicant does not concede that Failor has adequately implemented a Trendelenburg mechanism, Applicant does acknowledge that, as was common at the time, Failor appears to appreciate the importance of such therapeutic modalities.

Turning now to the second prong of *Graham* and examining the differences between the prior art, taken as a whole, and the recitation of claim 1, read as a whole, it is immediately noted that whereas Applicant recites a structure capable of manipulating a bariatric patient in a manner enabling therapeutic benefits for the bariatric patient, such as Trendelenburg therapy and cardiac chair function, the prior art contemplates therapeutic structures for the normal weight patient only – conspicuously omitting such modalities from bariatric beds in favor of greater structural rigidity. This is no small omission, as it is commonly known that bariatric patients are particularly prone to respiratory complications and are among those most likely to benefit from such clinical modalities as Trendelenburg therapy and cardiac chair positioning.

The only remaining question in the obviousness determination is then whether one of ordinary skill in the art would have been motivated to bridge the gap between the teachings of the prior art and the invention as positively claimed by Applicant. The metric by which this question must be answered is whether there existed in the prior art itself at the time of Applicant's invention some suggestion for the combination such that the skilled artisan would not only have been motivated to complete the invention but also would have been left with a reasonable expectation of success. *See* MPEP §2141, last paragraph. Clearly, no such suggestion is to be found. The prior art absolutely segregates bariatric care from the care of normal weight patients. It was not until Applicant's present invention and, in particular, Applicant's

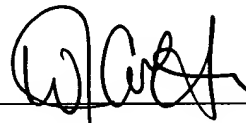
teaching of a structure capable of lengthwise tilting of a bariatric patient, that bariatric patients were afforded the care provided to all others, notwithstanding the long felt but unfulfilled need for a structure capable of providing such care. As a result, Applicant is entitled to patent protection for its contribution to the art. Withdrawal of the rejection of claim 1, as well as the rejection of each claim dependent therefrom, is therefore respectfully requested.

In light of all the foregoing, Applicant respectfully requests reconsideration and allowance of the claims and passage to issue of this present application.

Respectfully submitted,

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**WAYNE J. COLTON, INC.**  
The Milam Building Suite 1108  
115 East Travis Street  
San Antonio, Texas 78205  
Telephone: 210 222 8455  
Telecopier: 210 222 8445

  
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Wayne J. Colton  
Agent for Applicant  
Registration No. 40,962